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Paul V. Greco

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GORDON & JACOBSON, P.C.
60 LONG RIDGE ROAD
SUITE 407
STAMFORD, CT 06902

EXAMINER

LEFF, STEVEN N

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/805,695
Filing Date: March 22, 2004
Appellant(s): GRECO ET AL.

Jay P. Sbrollini
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 13th, 2008 appealing from the Office action mailed January 9th, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct, where it is noted that 19 claims were originally filed and not 20.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

GB 2247001	Arcari	2-1992
3257212	Kasket	6-1962
6221309	Kim	4-2001
2193974	Luckhaupt	7-1938

www.mightybeancoffee.com. "Tea Rock" teabag weight, March 2004.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 1-5, 10-13, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) and further in view of Kim (6221309) as evidenced by www.mightybeancoffee.com ("Tea Rock" teabag weight, March 2004).

With respect to claims 1-5, 10-13, and 18-19, Arcari teaches a body portion comprising overlying layers of porous material (pg. 4 lines 10-14) that are joined to form at least one compartment (pg. 4 line 15+), said at least one compartment carrying infusion beverage product (pg. 4 line 5), such as coffee, tea, or milk powder (pg. 4 line 11+).

Arcari further teaches that the at least one compartment carries an agent that imparts flavor into a solution during steeping (pg. 4 line 6+), that the layers of porous material are joined together by stitching to form the at least one compartment, and that the at least one compartments comprises a first compartment distinct from a second compartment, where the first compartment carries an infusion beverage and the second compartment carrying the weight.

Arcari further teaches that the weight comprises a dissolvable agent, where the dissolvable agent comprises a sweetener, such as sugar (pg. 4 line 7+). In addition, the porous material comprises a sheet of fibrous cellulosic material which withstands immersion into boiling water without damage, as well as being non-toxic, odorless, and flavorless. Regarding claim 10, Arcari teaches that the envelope is made of "perforated paper" (pg. 4 line 10+) where paper is made from cellulose.

With respect to claim 11, Arcari teaches that the pouch (7) is "placed into a container of hot or boiling water" (pg. 4 line 19+). Therefore, since the package of Arcari is intended to be used in an environment, which includes boiling water without degrading the package, Arcari would be expected to meet the limitations of claim 11. Arcari continues by teaching that the beverage package includes a string anchored to the body portion at one end of the string and a tag at the other end of the string (pg. 4 line 17).

With respect to the "weight", it is noted that the beverage materials would have a weight that would contribute to the total weight of the infusion package, where it is further noted that cancelled claim 8 specifically taught that the weight comprises a dissolvable agent.

However Arcari is silent with respect to the use of a "sinkable weight" which is from the group consisting of ceramic material, porcelain material, and naturally occurring rock material.

With respect to claims 1-5, 10-13, and 18-19, Kasket (3257212) teaches a non-floating beverage package, which will remain fully immersed in the infusion liquid and resist any tendency to float (col. 1 line 31+). Kasket continues by teaching a body portion, which comprises overlying layers of porous material (col. 2 line 5+) that are joined to form at least one compartment (col. 1 line 61+), said at least one compartment carrying infusion beverage product (col. 1 line 10+), in addition to a weight that causes said body portion to sink in water. It is noted that in this instance the weight is taken to be the weight described on lines 37+ of column 2, where the weight is a non-toxic, water-insoluble weight (col. 2 line 38), however Kasket does not specifically recite that the weight may be within the same porous body portion as the infusion beverage product.

However with respect to claims 1-5, 10-13, and 18-19, it would have been obvious to one of ordinary skill in the art to incorporate the weight, which Kasket discloses, into the invention of Arcari, since Arcari teaches the desire to provide a package which can form a beverage when the package is immersed in water (abstract), and since Kasket teaches using a non-toxic, insoluble material as a weight (col. 2 lines 38-40) for its art recognized and appellants intended purpose of increasing the rate at which all of the gases are forced to exit the infusible substance when immersed in the liquid, and thereby increases the density of the infusible substance as compared to water. Due to this increased weight and density, the package is forced to sink to the bottom of the container in a timelier manner, as opposed to a beverage package which tends to float or rise thus preventing effective infusion of the beverage in the soluble base as is taught by Kasket (col. 1 lines 28-30). Subsequently the package is unable to float, as is taught by Kasket and therefore further avoids the need for steeping (col. 1 lines 31-36).

Further it would have been obvious due to the fact that providing the non-toxic, and insoluble material directly within the compartment which houses the infusion product, would allow for an overall reduction in the amount of material required due to the fact that only a single body portion is needed to house both the substance and a weight since the weight is non-toxic, and therefore would not harm the consumer and thus subsequently decrease the overall cost of the product since the amount of needed material is reduced. In addition, by providing the weight within the same body, the package becomes a one-time use package and thus increases the number of overall sales since the weight may not be re-used.

Further, although both Arcari, and Kasket are silent to the use of a weight material which is specifically ceramic, Kasket teaches a non-toxic, naturally occurring weight material (col. 2 lines 38-40), where the weight material is specifically steel, nickel, or the like. However Kim does specifically teach a ceramic weight material for its art recognized and appellant's intended function of, not only causing the body to sink in a liquid, but further in order to provide a pure earth material ceramic weight (col. 2 line 17), which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56). Therefore it would have been obvious to one of ordinary skill in the art to substitute the steel or nickel weight of Kasket, with the pure earth material ceramic weight (col. 2 line 17), which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56) as is taught by Kim, since ceramic is well known in the art as a microwave safe material which is used as a weight for helping a tea bag sink, as is evidenced by the "Tea Rock" teabag ceramic weight described by www.mightybeancoffee.com (March 2004).

Therefore Kim is relied upon for the express purpose of replacing the metal weight of Kasket, where Kasket teaches a non-toxic metal steel, or nickel weight and where Kim further teaches a microwave safe, non-toxic ceramic pure earth material (col. 2 line 17).

- Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) in further view of Kim (6221309) as evidenced by www.mightybeancoffee.com ("Tea Rock" teabag weight, March 2004) and in view of Luckhaupt (2193974).

Arcari, Kasket and Kim are taken as above, however all are silent with respect to the tag carrying product indicia.

With respect to claim 14 Luckhaupt teaches "an improved package for packaging and utilization of infusing material such as tea, coffee, and the like." (pg. 1 col. 1 line 2+). More specifically Luckhaupt teaches, at figure 10, that the tag may carry product indicia.

Therefore with respect to claim 14 it would have been obvious to one of ordinary skill in the art to provide the product indicia on the string tag of Luckhaupt into the string tag of Arcari since both are directed to infusible packages, and a string and tag attached

to the infusible package in order to remove the infusible package from the liquid, and further since the product indicia would allow the consumer to identify the product. It is further noted that MPEP 2144.04 (I) states “that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art”.

- Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arcari (GB 2247001) in view of Kasket (3257212) in further view of Kim (6221309) as evidenced by www.mightybeancoffee.com (“Tea Rock” teabag weight, March 2004) and in view of Rambold. (3542561)

Arcari, Kasket and Kim are taken as above, however all are silent with respect to the two body portions that extend from a hinged interface.

With respect to claims 15-17 Rambold teaches an “infusion bag containing an infusible substance such as tea, coffee or the like for preparing a beverage.” (pg. 1 col. 1 line 21+) More specifically Rambold teaches “an infusion bag comprising at least three chambers all containing infusible substance with two outer chambers connected by a closure. At least one of the chambers has a transverse bend so as to allow the bag to be packaged in a flat condition. During use the bag is in a generally polygonal ring-like form with the lateral chambers spread apart.” (abstract)

With respect to claims 15-17, although Arcari teaches a compartmentalized infusion beverage package, which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that a hinge separates two body portions. Rambold does teach a bottom wall which folds for packaging and separates two body portions. Therefore, although Arcari does not teach two body portions that extend from a hinged interface, or a bottom wall which may be folded for packaging, one of ordinary skill would have been motivated to combine the teachings of Kasket and Rambold in order to produce an infusion beverage package which is capable of being more easily and compactly packed for distribution thus decreasing the overall size of the package and increasing the number of packages in a given area due to the body portions by being folded together into a relatively flat condition as Rambold teaches (abstract).

Regarding claim 16, although Arcari teaches a compartmentalized infusion beverage package which includes a first compartment that includes a weight in the bottom part thereof and a second compartment, spaced from the first, containing an infusion beverage product, Arcari is silent to the fact that two body portion are separated by a hinge, however Arcari does teach that the overall package contains a third bottom compartment containing a weight. Where Rambold does teach two body portions that extend from a hinged interface and further teaches a third “bottom” compartment. In addition, both references teach infusion beverage packages, which would allow for preparation of a beverage, Rambold teaches providing a space that would allow the liquid to flow between the compartments due to the separation of the bodies, where providing more than one chamber would cause the infusion substance to be spread out over a number of chambers and consequently over a larger surface area, thus producing a thinner layer of the substance. A thinner layer of the substance will consequently allow the infusion substance to be more effectively extracted by the infusing liquid. The weight in the bottom wall would increase the overall weight of the package thus preventing floating and causing the package to be completely submerged in the infusing liquid. Therefore, one of ordinary skill would have been motivated to combine the teachings of Arcari and Rambold in order to produce a hinged area between two separate bodies where the two bodies are further separated by a third body forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time as is taught by Rambold (col. 2 line 45+).

Therefore with respect to claims 15-17, it would have been obvious to one of ordinary skill in the art at the time of the invention by the appellant to have produced a beverage infusion package, which includes a weight and further where the package could be folded for packaging and increasing the effectiveness of the package.

(10) Response to Argument

Response to Argument A.1.

It is initially noted that cancelled claim 8 taught that the “weight comprises dissolvable material” and thus Arcari teaches a multi-compartment infusion bag which contains a “weight” since the beverage materials would contribute to the total weight of the infusion package, although not a ceramic weight.

Appellant initially argues that "when considering the obviousness of a combination of known elements, the operative question is whether the improvement is more than the predictable use of prior art elements according to their established function" *KSR International Co. v. Teleflex Inc.*, 550 U.S., 80 USPQ2d at 1396 (2007). Although, Arcari is silent with respect to the weight being made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, secondary reference Kasket teaches a non-toxic metal weight, specifically a steel, or nickel weight, and the advantage achieved by providing a weight made of a metal material whereby the package is unable to float, as is taught by Kasket and therefore further avoids the need for steeping (col. 1 lines 31-36). Therefore since Kasket teaches a metal weight for its art recognized and appellant's intended purpose of causing the infusion package to sink in a liquid, the operative question is whether the improvement is more than the predictable use of prior art elements according to their established function where it is the Office's view that providing a weight being made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material would yield predictable results to one of ordinary skill in the art at the time of the invention where combining the two infusion packages flows logically from their having been individually taught in the prior art (see MPEP 2144.06). In addition the claim would have been obvious because “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp, and if this leads to the anticipated success, i.e. in the instant case a " non-floating beverage package”, it is likely the product not of innovation but of ordinary skill and common sense.

In the instant case Arcari teaches a multi-compartment infusion bag which contains a “weight” since the beverage materials would contribute to the total weight of the infusion package, although not a ceramic weight. Kasket teaches a “non-floating beverage package” as is stated by the title, and specifically the use of a metal as a sinkable “weight” to achieve its art recognized and appellant's intended purpose of forming a " non-floating beverage package” due to a sinkable weight, however the metal weight is not specifically ceramic. Kim teaches the specific material, and more specifically a "ceramic metal weight", and therefore it would have been obvious to one of ordinary skill in the art since all the claimed elements were known in the prior art and one skilled in the art could have substituted the

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elements with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the two methods, each of which is taught by the prior art to be useful for the same purpose, flows logically from their having been individually taught in the prior art (see MPEP 2144.06). In addition the claim would have been obvious because “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp, and if this lead to the anticipated success, i.e. in the instant case a “non-floating beverage package”, it is likely the product not of innovation but of ordinary skill and common sense.

Appellant argues that Arcari does not teach a porous body portion carrying both infusion beverage product and a weight made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material as required by claim 1.

It is initially noted that cancelled claim 8, and the specification specifically teach that the weight may comprise a dissolvable agent.

It is further noted with respect to appellant’s argument on page 11 lines 1-3 that the features upon which appellant relies (i.e., a porous body portion carrying both infusion beverage product and a weight) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claim 1 requires “a body portion comprising overlying layers of porous material that are joined to form at least one compartment, said at least one compartment carrying infusion beverage product in addition to a weight.” Therefore, claim 1 is not limited to only a single compartment for holding both the infusion product and the weight, but “at least one compartment” made of porous material where Arcari positively teaches the infusion beverage package being made entirely of a porous material (pg. 4 lines 10-14). It is further noted that claim 4 requires that the infusion product and weight be located in separate “distinct” compartments.

Appellant further argues that Arcari fails to teach, suggest, or even make mention of a weight or the concept of weighing down the beverage pack, however it is initially noted that cancelled claim 8, and the specification specifically teach that the weight may comprise a dissolvable agent, where it is further noted that claim 1 teaches an infusion beverage package comprising “at least one compartment carrying infusion beverage product in addition to a weight”. Thus, since the term “weight” is defined as anything that would provide an increased “heaviness” when compared to the “heaviness” or weight of the infusion product alone, where the infusion product is within porous compartment 4 of figure 2, and since compartments 2, 1a, and 1b provide an additional heaviness or “weight” due to the product within the

compartments and the additional material needed to form these compartments when compared to the weight of the infusion compartment 4 of figure 2 alone, Arcari positively teaches an infusion beverage package comprising a body portion comprising overlying layers of porous material that are joined to form at least one compartment, said at least one compartment carrying infusion beverage product in addition to a weight.”

With respect to appellant’s argument regarding the non-final Office Action of July 2007 and the Office interpretation of the reference, it is noted that appellant’s amended claims of October 2007 in the response to the Office Action of July 2007 necessitated the examiner withdrawing the 102(b) rejection of the claims, where the Final 103(a) rejection was made in light of the amended claims which introduced further limitations into claim 1, and with a different interpretation of the reference in light of these amendments.

Regarding appellant’s argument on page 13 of the response that Arcari does not teach a porous body, appellant is urged to page 4 lines 10-14. Regarding Arcari being silent with respect to the at least one compartment carrying both the weight and infusion beverage product, it is noted that figure 2 teaches an infusion package consisting of different compartments of porous material where figure 2 clearly depicts an infusion beverage package with at least one compartment of porous material for carrying an infusion substance (ref. 4 fig. 2) in addition to clearly depicting a "weight" (fig. 2 ref. 1a, 1b, and 2) within the at least one porous compartment or package.

Appellant further states on page 13 of the response that Arcari is silent with respect to the weight being made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material, however one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, secondary reference Kasket teaches a non-toxic metal weight, specifically a steel, or nickel weight, and the advantage achieved by providing a weight made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material whereby the package is unable to float, as is taught by Kasket and therefore further avoids the need for steeping (col. 1 lines 31-36).

Response to Argument A.II.

In response to appellant’s argument that Kasket teaches away from the claimed invention, it has been held that a prior art reference must either be in the field of appellant’s endeavor or, if not, then be

reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case Kasket is relied upon to teach a weight of a non-toxic, water-insoluble substance (col. 2 line 38).

Therefore although Kasket does not specifically recite that the weight may be within the same porous body portion as the infusion beverage product, Kasket is not used to teach this limitation since the infusion product and the weight both within porous bodies is already taught by Arcari. Kasket is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely using a non-toxic, insoluble material as a weight (col. 2 lines 38-40), for its art recognized and appellant's intended purpose of causing the infusion package to sink to the bottom of the container in a timelier manner, as opposed to "a weight" which requires the release of gases itself prior to acting as a weight as is taught by Kasket (col. 1 lines 23-30), thus the package is unable to float and therefore avoids the need for steeping (col. 1 lines 31-36), and in combination with the primary reference, discloses the presently claimed invention.

In addition appellants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an appellants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Kasket, therefore, is a reasonably pertinent reference, because it teaches combining an insoluble weight material for its art recognized and appellant's intended purpose of causing the infusion package to sink to the bottom of the container, which is a function especially pertinent to the invention at hand. Further in response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Arcari and Kasket teach infusion packages where one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding appellants argument on pages 14-15 that Kasket teaches a weight in the form of wetted infusion material, it is noted that appellant's amended claims of October 2007 in the response to the Office Action of July 2007 necessitated the examiner withdrawing the 102(b) rejection of the claims, where the Final 103(a) rejection was made in light of the amended claims which introduced further limitations into claim 1, and with a different interpretation of the reference in light of these amendments. Therefore appellant is urged to page 3, paragraph 4 of the Final Office action which states that the weight is taken as the weight described at column 2 lines 35-43.

With respect to appellant's argument on page 15 that the examiner has applied improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, Arcari positively teaches a weight and an infusion product carried in the same porous package and thus although Kasket does not teach the weight housed in a porous compartment, Kasket does teach a non-toxic, insoluble material as the weight. Therefore, since Arcari teaches a weight and an infusion product carried in the same porous package, and in light of the weight as taught by Kasket in conjunction with an infusion substance and package, it would have been obvious to one of ordinary skill in the art to house the weight of Kasket and the infusion product in the same porous package since the primary reference, Arcari, teaches such.

In response to appellant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Regarding appellant's statements "that tea bags have been around for nearly one hundred years" which speaks to the novelty of the appellant's invention, it is noted that these statement amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments A.III.

In response to appellant's argument that Kim teaches away from the claimed invention, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case Kim is relied upon to teach a ceramic weight material for its art recognized and appellant's intended function of, not only causing the body to sink in a liquid, but further in order to provide a weight, which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56).

Therefore although Kim does not specifically recite that the weight may be within the same porous body portion of an infusion beverage product, Kim is not used to teach this limitation since the infusion product and the weight both within porous bodies is already taught by Arcari. Kim is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely for the express purpose of replacing the steel or nickel metal weight as taught by Kasket, with a non-toxic ceramic weight as is taught by Kim since Kim has treated the weight material with extreme heat thereby producing a pure ceramic and thus Kim has increased the number of different application to which the ceramic material may be applied, specifically as a weight for helping a tea bag sink, as is evidenced by the "Tea Rock" teabag ceramic weight described by www.mightybeancoffee.com (March 2004).

In addition appellants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an appellants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Kim, therefore, is a reasonably pertinent reference, because it teaches a weight which not only causes the body to sink in a liquid, but further in order to provide a ceramic weight, which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56), which is a function especially

pertinent to the invention at hand since it would be undesirable to have a metal weight degrade in the substance which is to be consumed by a person.

Response to Arguments A.IV.

In response to appellant's argument that www.mightybeancoffee.com teaches away from the claimed invention, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case www.mightybeancoffee.com is relied upon to teach that ceramic is well known in the art as a microwave safe material which is used as a weight for helping an infusion package sink.

Therefore although www.mightybeancoffee.com does not specifically recite that the weight may be within the same porous body portion of an infusion beverage product, www.mightybeancoffee.com is not used to teach this limitation since the infusion product and the weight both within porous bodies is already taught by Arcari. www.mightybeancoffee.com is used as an evidentiary reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely that ceramic is a microwave safe material which is used as a weight for helping an infusion package to sink.

In addition appellants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an appellants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." www.mightybeancoffee.com, therefore, is a reasonably pertinent reference, because it teaches a ceramic which is, non-toxic, insoluble, odorless, flavorless and will not degrade (col. 2 line 48-56), in addition to positively teaching the ceramic weight in conjunction with an infusion beverage package for its art recognized and appellant's intended purpose of causing the infusion package to sink to the bottom of the container which is a function especially pertinent to the invention at hand.

Regarding appellant's citation of KSR, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), where in the instant case combining the two packages, each of which is taught by the prior art to be useful for the same purpose, flows logically from their having been individually taught in the prior art (see MPEP 2144.06) and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination,” where www.mightybeancoffee.com, teaches a ceramic weight in conjunction with an infusion beverage package for its art recognized and appellant’s intended purpose of causing the infusion package to sink to the bottom of the container which is a function especially pertinent to the invention at hand and appellant’s patentable feature. However, it is further noted that www.mightybeancoffee.com specifically teaches a ceramic stone with respect to an infusion substance and thus the claim is obvious because “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp, and if this lead to the anticipated success, i.e. in the instant case a " non-floating beverage package”, it is likely the product not of innovation but of ordinary skill and common sense.

Regarding appellant’s statements “that tea bags have been around for nearly one hundred years” which speaks to the novelty of the appellant’s invention, it is noted that these statement amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

It is further noted regarding appellant’s statement that “despite the apparent simplicity of appellant’s invention, every invention is arrived at in part through using known devices and knowledge to produce something that is unknown”, that Arcari teaches a multi-compartment infusion bag which contains a “weight”, although not a ceramic weight. Kasket teaches a “non-floating beverage package” as is stated by the title, and specifically the use of a metal as a “weight” to achieve its art recognized and appellant’s intended purpose of forming a " non-floating beverage package”, however the metal weight is not specifically ceramic. Kim teaches the specific material, and more specifically a "ceramic metal weight", and therefore it would have been obvious to one of ordinary skill in the art since all the claimed elements were known in the prior art and one skilled in the art could have substituted the elements or arrangements with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the two methods, each of which is taught by the prior art to be useful for the same purpose, flows logically from their having been individually taught in the prior art (see MPEP 2144.06).

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments B.1

Appellant does not provide separate arguments for claims 2-3. Therefore, these claims should stand or fall together with parent claim 1.

Response to Arguments B.II.

Appellant further states on page 19 of the response that Arcari is silent with respect to the weight being made from the group consisting of ceramic material, porcelain material, and naturally-occurring rock material, however one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, Arcari positively teaches the infusion product and weight being carried in two distinct compartments (fig. 2), when the weight is taken as a dissolvable agent as taught by cancelled claim 8.

Response to Arguments B.III.

Appellant does not provide separate arguments for claim 5. Therefore, the claim should stand or fall together with parent claim 1.

Response to Arguments B.IV.

Appellant argues that Kasket does not teach “cellulose” as the envelope material. However although Kasket does not specifically recite “cellulose” as the envelope material, Kasket is not used to teach this limitation since this is already taught by primary reference Arcari (pg. 4 line 10-14), where it is noted that Kasket does teach paper as the material of the envelope where paper would naturally include cellulose. Therefore since both references teach the use of paper, where Arcari teaches “cellulose”, Kasket is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973).

Response to Arguments B.V.

Appellant does not provide separate arguments for claim 11-15. Therefore, these claims should stand or fall together with parent claim 1.

Response to Arguments B.VI.

Appellant further states on page 20 of the response that Arcari is silent with respect to teaching two body portions which extend from a hinged surface, and a bottom wall extending between the two body portions to define a space for solution to flow through during steeping, however one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), where in the instant case the rejection is in further view of Rambold.

Regarding appellant's argument that Rambold does not teach carrying a weight in a bottom compartment, although Rambold does not specifically teach "a weight in a bottom compartment" Rambold is not used to teach this limitation since this is already taught by primary reference Arcari (pg. 4 line 10-14).

Rambold is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973).

Therefore although Rambold does not teach carrying a weight in a bottom compartment, Rambold is not used to teach this limitation since the weight is already taught by Arcari, and Kasket. Rambold is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely two body portions that extend from a hinged interface and further a third "bottom" compartment

In addition appellants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an appellants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Rambold therefore, is a reasonably pertinent reference, because it teaches two body portions that

extend from a hinged interface and further a third “bottom” compartment, which is a function especially pertinent to the invention at hand.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case both references teach infusion beverage packages, which would allow for preparation of a beverage, where Arcari teaches multiple compartments, and Rambold teaches providing a space that would allow the liquid to flow between the compartments due to the separation of the bodies, where providing more than one chamber would cause the infusion substance to be spread out over a number of chambers and consequently over a larger surface area, thus producing a thinner layer of the substance. A thinner layer of the substance will consequently allow the infusion substance to be more effectively extracted by the infusing liquid. The weight in the bottom wall would increase the overall weight of the package thus preventing floating and causing the package to be completely submerged in the infusing liquid. Therefore, one of ordinary skill would have been motivated to combine the teachings of Arcari and Rambold in order to produce a hinged area between two separate bodies where the two bodies are further separated by a third body forming a bottom wall and containing a weight in order to cause the package to be more conducive to attaining the most advantageous rate of flow through the package and through the infusing substance thus allowing the same concentration of the beverage to be attained in a shorter amount of time as is taught by Rambold (col. 2 line 45+).

Response to Arguments B.VII.

Appellant does not provide separate arguments for claim 17-19. Therefore, these claims should stand or fall together with parent claim 1.

In summary, Arcari teaches a multi-compartment infusion bag which contains a “weight”, where it is noted that cancelled claim 8 and the specification teach the weight being “a dissolvable agent”, although not a ceramic weight. Kasket teaches a “non-floating beverage package” as is stated by the title, and specifically the use of a metal as a “weight” to achieve its art recognized and appellant's intended purpose of forming a “non-floating beverage package”, however the metal weight is not specifically

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ceramic. Kim teaches the specific material, and more specifically a "ceramic metal weight", and therefore since all the claimed elements were known in the prior art, one skilled in the art could have substituted the elements or arrangements with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the packages, each of which is taught by the prior art to be useful for the same purpose, flows logically from their having been individually taught in the prior art (see MPEP 2144.06). Therefore, since all of the elements were known in the prior art for their art recognized and appellant's intended purpose of providing a non floating infusion bag, as is specifically stated by the title of Kasket, and using a metal weight to achieve such, any minor differences such as the weight material itself, or where the weight is placed with the infusion bag would not result in unexpected results.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Steven Leff/

Examiner, Art Unit 1794

Conferees:

/Drew E Becker/

Primary Examiner, Art Unit 1794

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700